

REMARKS

Claims 5-8 and 10-11 are now pending in the application. Claims 1-4 and 9 have been cancelled by this Amendment. Minor non-narrowing amendments have been made to the claims to simply overcome the rejections of the claims under 35 U.S.C. § 112. The amendments to the claims contained herein are of equivalent scope as originally filed and, thus, are not a narrowing amendment. The Examiner is respectfully requested to reconsider and withdraw the rejections in view of the amendments and remarks contained herein.

REJECTION UNDER 35 U.S.C. § 112

Claims 1-11 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point and distinctly claim the subject matter which Applicant regards as the invention. This rejection is respectfully traversed.

Claims 1-4 and 9 have been cancelled and therefore rejections thereto are rendered moot.

Independent claims 5 and 7 have been amended to recite having "a dielectric breakdown strength of greater than 21.1 kV/mm". As the Examiner notes, support for this lower limit is found in Table 1 of the originally filed application. As disclosed in the originally filed description, it is comparative Example No. 1 that includes a dielectric breakdown strength of 21.1 kV/mm. As stated in the originally filed specification, it is one property of the claimed invention to have a dielectric breakdown strength greater than that of other materials. Therefore, the dielectric breakdown strength would generally be understood to be greater than that found in the comparative examples. Therefore, having a dielectric breakdown strength of greater than 21.1 kV/mm is taught by the original specification and the dielectric breakdown strength of Example No. 2 is merely an exemplary dielectric breakdown strength.

Applicants further submit that open ended upper limits are supported by the application as filed and are not indefinite. Specifically, "greater than" in the pending claims is not so indefinite as to be not allowable in light of the originally filed specification. Generally, "open-ended claims, however, would be limited by what a person skilled in the art would understand to be workable". See *Ralston Purina Co. v. Far-Mar-Co., Inc.*, 227 U.S.P.Q. 177, 180 (Fed.Cir. 1985) (Copy attached hereto). As disclosed in the original specification, the dielectric breakdown is higher when the clay is dispersed in a model layer so that the current must take a non-direct path through the material. See page 6, *Ins. 20-24*. Therefore, it is implicit that the amount of the clay and how it is positioned in the material will affect the dielectric strength. In addition, the amount of the clay may vary depending upon the composition and other selected characteristics. Therefore, the amount of clay may differ depending upon a specific embodiment that is chosen to be formed. See page 4, *Ins. 21-32*. Claims 5 and 7 both recite a range of clay amounts.

The examples included in the original description are merely exemplary of various embodiments to illustrate the various characteristics of different embodiments all of which are covered by the claims. The breadth of the claims is not to be limited by the specific examples. Therefore, the dielectric strength need not necessarily be limited to any of the examples included, but would generally be understood to be limited only by a specific composition that is within the scope of the presently pending claims. As further recited, in each of independent claims 5 and 7, the method includes "between 1 and 15 parts by weight of an organic clay dispersed in the polymer". Therefore, one skilled in the art would be able to measure the dielectric breakdown strength of such a composition.

Similarly, the tensile modulus is only exemplary defined to include a lower limit of 2.59, as illustrated in Table 1, and an upper example of 3.35 GPa. In addition, as illustrated in Table 1, the tensile modulus of the material depends upon the composition of the material. Therefore, the modulus of the material can vary depending upon the exact composition as presently

claimed. In addition, one skilled in the art would be able to determine whether the material as formed by the method as claimed would include a modulus that is at least 2.59 GPa through generally known testing techniques.

Therefore, it is believed that the limitations "having a tensile modulus of at least 2.59 GPa" and "a dielectric breakdown strength of at least 21.9 kV/mm" or "a dielectric breakdown strength of greater than 21.1 kV/mm" are not indefinite. Simply, including a lower limitation provides enough definition to the claim in light of the other limitations to allow one skilled in the art to know the scope of the claims as pending. Moreover, the upper limitations depend upon various specific embodiments that may be produced according to the presently claimed method. Therefore, in light of the description, the claims as amended, and the case law, the Applicant believes that claims 5-8, 10, and 11 are allowable in light of the cited art.

REJECTION UNDER 35 U.S.C. § 103

Claims 1-4 and 9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Abolins (U.S. Pat. No. 4,692,490) in view of Takekoshi et al. (U.S. Pat. No. 5,707,439 or 5,530,052) and further in view of Pinnavaia et al. (U.S. Pat. No. 6,096,803) or Vaia et al. (U.S. 6,225,374. This rejection is respectfully traversed.

The claims 1-4 and 9 have been cancelled. Therefore, the rejections thereto are rendered moot.

ALLOWABLE SUBJECT MATTER

The Examiner indicated that claims 5-8, 10, and 11 would be allowable if amended or rewritten to overcome the rejection under 35 U.S.C. § 112, first and second paragraphs. By this amendment and the remarks included herein, the Applicant believes that the rejections under § 112, first and second paragraph, have been overcome. Therefore, the Applicant believes that claims 5-8, 10 and 11 are in condition for allowance and request that the Examiner allow the same.

CONCLUSION

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Dated: _____

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Respectfully submitted,

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